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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20061208

Application Number: 09/915,438

Filing Date: July 26, 2001

Appellant(s): Dutta et al.

H. Artoush Ohanian
(Reg. No. 46,022)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed October 2, 2006.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(Assignee of record, *International Business Machines, Inc.*)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 1-20 are pending, rejected, and appealed.)

(Claims 21-60 remain pending, but stand withdrawn from further consideration.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(No after-final amendments have been filed.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 1-6 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al. (US 6,460,020).
- II. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al. (US 6,460,020), in view of Seigel et al. (US 2001/0051876).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 6,460,020	Pool et al.	10/2002
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US 2001/0051876	Seigel et al.	12/2001
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(9) *Grounds of Rejection*

I. Claims 1-6 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al. (US 6,460,020).

Regarding claims 1, 2, 12, and 13, Pool et al. disclose a method for facilitating customs planning and clearance, the method comprising the steps of: creating a master customs planning record and a related customs planning record in at least one international customs server, in response to signals communicated through a client device coupled for data communications through at least one Internet connection to the at least one international customs server, and the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise, but Pool et al. do not specifically disclose that the respective customs planning records each individually comprise all of the specific data elements, as claimed. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have arranged any of the calculated and stored data elements of Pool et al. so as to be stored in the specific arrangement/manner of the instant claims, simply as a matter of design choice, since so doing could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 3, each related customs planning record of the method of Pool et al. represents a prospective importation into a destination country of a quantity of goods of a category.

Regarding claims 4-6, the method of Pool et al. further comprises creating, in dependence upon the related customs planning record, a customs declaration form for a destination country, submitting the form to a customs declaration forms database for the destination country, and submitting, to the customs service of the destination country, payment of the duty.

Regarding claim 11, Pool et al. disclose that the at least one Internet connection can be wireless.

Regarding claim 14, the method of Pool et al. further comprises that the international customs server is a software application installed and operating on one or more computers, the software application further comprising software routines storing and retrieving related customs planning records, validating goods described in related customs planning records against customs regulations stored in customs regulations databases, and submitting to customs databases declaration forms prepared in dependence upon the related customs planning records.

Regarding claim 15, the method of Pool et al. includes that creating in dependence upon the related customs planning record a customs declaration form for the destination country further comprises reading customs data from a related customs planning record and inserting the read customs data into a declaration form.

Regarding claim 16, the method of Pool et al. further includes that submitting the customs declaration form to a customs declaration forms database for the destination country

further comprises communicating the form as electronic data communications through at least one Internet connection.

Regarding claim 17, the method of Pool et al. further comprises validating goods described in a related customs planning record by comparing the goods described by customs data in the related customs planning record to customs regulations governing the goods described by the customs data in the related customs planning record, storing the result of the comparison in the related customs planning record, and reporting to an importer through the client device a result of the comparison.

Regarding claim 20, the method of Pool et al. further comprises that the related customs planning record comprises a related customs planning record form having a structure, wherein the structure of the related customs planning record form is dependent upon customs regulations.

II. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al. as applied to claim 1 above, and further in view of Seigel et al. (US 2001/0051876).

Pool et al. disclose a method for facilitating customs planning and clearance, as applied above to claim 1, but Pool et al. fail to disclose the client device as specifically being any of: a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal computer; or, a hand-held personal data administrator (PDA).

However, Seigel et al. disclose a similar method that also requires accessing the Internet, as does the method of Pool et al., and the method of Seigel et al. specifically discloses that the client device used to access the Internet can indeed be any of: a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal computer; or, a hand-held personal data administrator (PDA). See, in particular, paragraphs 16 and 60-62.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Pool et al. so as to use a client device comprising any of a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal computer; or, a hand-held personal data administrator (PDA), in accordance with the teachings of Seigel et al., in order to provide easy and convenient access to the Internet.

(10) Response to Argument

I. Claims 1-6 and 11-20 are unpatentable under 35 U.S.C. 103(a) for being obvious over Pool et al. (US 6,460,020).

Regarding the argument that the rejection is based on well known prior art according to MPEP § 2144.03, the rejection is not based on well known prior art according to MPEP § 2144.03. The rejection is based on design choice, which is to say that, while the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning

record comprise, the method of Pool et al. is not disclosed as having the respective customs planning records each individually comprise all of the respective data elements, as claimed by applicant. However, because there is nothing special (non-obvious) about storing the information in a data structure such as that of applicant's claimed invention, as compared to storing the same information in a different data structure/arrangement, such as disclosed by Pool et al., the difference is considered obvious (non-patentably distinct) to one of ordinary skill in the art, because one of ordinary skill in the art would be readily and easily able to make the change, with neither undue experimentation, nor risk of unexpected results, which is the main test for obviousness/non-obviousness. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

Regarding the argument that the Pool et al. reference is too complex and shows too many other inventions for applicant to understand, the disclosure of Pool et al. is directly on point with respect to applicant's invention, and is considered neither complex nor lengthy to those of ordinary skill in the art.

Regarding the argument that the invention of Pool et al. is a different invention than applicant's invention because the disclosure of Pool et al. fails to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Regarding the argument vis-á-vis inherency, the disclosure in a reference can be either explicit or inherent. Elements are considered inherent when they are necessarily present. In this case, the invention of Pool et al. could not perform as disclosed without knowing/determining all of the recited elements of data/information. Therefore, the elements are indeed properly considered inherent.

Regarding the argument that there is no suggestion to modify the reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to modify the prior art would be found in the knowledge generally available to one of ordinary skill in the art.

Regarding the argument that Pool et al. teaches away from the instant invention, the disclosure of Pool et al. does not teach away from the instant invention because the disclosure of Pool et al. discloses, in all respects, the exact same invention as claimed by applicant except for not explicitly disclosing storing the same elements of information/data in the exact same manner/arrangement as applicant. See, for example, the abstract.

Regarding the argument that Pool et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Pool et al. is both in the field of applicant's endeavor, and, is completely pertinent to the particular problem with which applicant was concerned.

Regarding the argument that the examiner has not determined the scope and contents of the prior art, the examiner has indeed determined the scope and contents of the prior art.

Regarding the argument that the examiner has not ascertained the differences between the prior art and the claims in issue, the examiner has indeed ascertained the differences between the prior art and the claims in issue.

Regarding the argument that the examiner has not resolved the level of ordinary skill in the art, it has been held that, if the only facts of record pertaining to the level of skill in the art are found within the prior art of record, an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. See *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 218 USPQ 673 (Fed. Cir. 1983).

To the extent that applicant is arguing, or intends to argue, that the examiner has failed to evaluate any evidence of secondary considerations, the instant matter includes no evidence of record pertaining to any secondary considerations to be considered, and mere arguments of counsel unsupported by competent factual evidence of record are entitled to little weight. See *In re Payne, Durden, and Weiden*, 203 USPQ 245 (CCPA 1979).

II. Claims 1-6 and 11-20 are unpatentable under 35 U.S.C. 103(a) for being obvious over Pool et al. (US 6,460,020), in view of Seigel et al. (US 2001/0051876).

Regarding the argument that the rejection is based on well known prior art according to MPEP § 2144.03, the rejection is not based on well known prior art according to MPEP § 2144.03. The rejection is based on design choice, which is to say that, while the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise, the method of Pool et al. is not disclosed as having the respective customs planning records each individually comprise all of the respective data elements, as claimed by applicant. However, because there is nothing special (non-obvious) about storing the information in a data structure such as that of applicant's claimed invention, as compared to storing the same information in a different data structure/arrangement, such as disclosed by Pool et al., the difference is considered obvious (non-patentably distinct) to one of ordinary skill in the art, because one of ordinary skill in the art would be readily and easily able to make the change, with neither undue experimentation, nor risk of unexpected results, which is the main test for obviousness/non-obviousness. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

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point with respect to applicant's invention, and is considered neither complex nor lengthy to those of ordinary skill in the art.

Regarding the argument that the invention of Pool et al. is a different invention than applicant's invention because the disclosure of Pool et al. fails to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Regarding the argument vis-á-vis inherency, the disclosure in a reference can be either explicit or inherent. Elements are considered inherent when they are necessarily present. In this case, the invention of Pool et al. could not perform as disclosed without knowing/determining all of the recited elements of data/information. Therefore, the elements are indeed properly considered inherent.

Regarding the argument that there is no suggestion to modify the reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941

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Regarding the argument that Pool et al. teaches away from the instant invention, the disclosure of Pool et al. does not teach away from the instant invention because the disclosure of Pool et al. discloses, in all respects, the exact same invention as claimed by applicant except for not explicitly disclosing storing the same elements of information/data in the exact same manner/arrangement as applicant. See, for example, the abstract.

Regarding the argument that Pool et al. and/or Seigel et al. is/are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, each of Pool et al. and Seigel et al. are in the field of applicant's endeavor, as well as being completely pertinent to the particular problem with which applicant was concerned.

Regarding the argument that the examiner has not determined the scope and contents of the prior art, the examiner has indeed determined the scope and contents of the prior art.

Regarding the argument that the examiner has not ascertained the differences between the prior art and the claims in issue, the examiner has indeed ascertained the differences between the prior art and the claims in issue.

Regarding the argument that the examiner has not resolved the level of ordinary skill in the art, it has been held that, if the only facts of record pertaining to the level of skill in the art are found within the prior art of record, an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. See *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 218 USPQ 673 (Fed. Cir. 1983).

To the extent that applicant is arguing, or intends to argue, that the examiner has failed to evaluate any evidence of secondary considerations, the instant matter includes no evidence of record pertaining to any secondary considerations to be considered, and mere arguments of counsel unsupported by competent factual evidence of record are entitled to little weight. See *In re Payne, Durden, and Weiden*, 203 USPQ 245 (CCPA 1979).

(11) Related Proceeding(s) Appendix

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



12/8/06

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

GJOC

December 8, 2006

Appeal Conference Held:

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